SUPREME COURT, U. S.
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In the Supreme Court of the United States

October Term, 1963

No. 272.

RIPPLE SOLE CORPORATION,
PETITIONER,

v.

AMERICAN BILTRITE RUBBER CO., INC.,
RESPONDENT.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Melvin R. Jenney
24 School Street
Boston 8, Massachusetts
Attorney for Respondent.

Richard R. Hildreth
Clarence S. Lyon
Of Counsel

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Counterstatement of the Question Presented

The sole question presented in this case is whether, after a patent has been held invalid and a final judgment of invalidity has been entered, the issue of validity can be relitigated between the same parties simply because the defendant brings out a different form of the article or device charged as an infringement.

Statement of the Case

The petitioner here attempts to relitigate the issues previously presented to this Court in the petitioner's petition for writ of certiorari, October Term, 1962, No. 313, which was denied on October 22, 1962, 374 U.S. 806.

The District Court had held the Hack patent invalid, and the decision of the District Court was affirmed by the Court of Appeals for the First Circuit, 302 F.(2d) 2. The petition for certiorari No. 313 referred to above was filed pursuant to the decision of the Court of Appeals.

After the decision of the Court of Appeals the defendant made and sold a form of shoe sole different from the sole charged as an infringement at the trial. The defendant's new sole is charged by the plaintiff to be a "Chinese copy" of the patented sole.

The petitioner then brought its motion under F.R.C.P. Rule 60(b) for relief from the judgment, which motion appears in the appendix to the petition, pages 21 to 25. The District Court granted a full hearing on the motion and even allowed the plaintiff to take additional testimony. The Court denied the motion on February 12, 1963 (opinion printed in petition, pages 26-28).

The plaintiff appealed from the denial of the motion by the District Court. On motion of the defendant the Court of Appeals affirmed the decision of the District Court without a hearing. The crux of the decision is in the following sentence from the opinion of the Court of Appeals (petition, page 33):

> "Moreover, after this court held the Hack patent invalid, its structure was open to the defendant-appellee to copy if it saw fit."

It is from the judgment of the Court of Appeals entered April 16, 1963 that this petition has been brought.

Argument

The District Court and the Court of Appeals having finally determined, after a full and fair trial and appeal, that as between these parties the Haek patent was invalid, the force and effect of this final judgment of invalidity cannot be vitiated or diminished by the subsequent manufacture of any article by the defendant.

It is clear from the decisions of this Court that Rule 60(b) is to be applied only under unusual circumstances. The character of the circumstances necessary for application of the rule is made clear in two cases decided by this Court, namely, *Klapprott* v. *United States*, 335 U.S. 601, in which relief under Rule 60(b) was granted, and *Ackermann* v. *United States*, 340 U.S. 193, in which relief was denied. There are no extraordinary or exceptional circumstances in this case that are compatable to those existing in either of those cases.

This is only a routine patent case in which a patent has been held invalid. The defendant now has a legal right to make anything it pleases, without molestation by the plaintiff under the patent, which, as between these parties, is invalid.

Even before the validity of a patent has been tested, a defendant may rely on the defense of invalidity, and copying by the defendant is no more than a factor which may tip the balance in a case where the issue of validity is in doubt. *Minnesota Mining & Mfg. Co.* v. *Industrial Tape Corp.* (C.A. 7, 1948) 168 F(2d) 7. *Hueber Products Co.* v. *U. S. Tyral Co.* (C.A. 1, 1958) 259 F(2d) 69. But where, as here, all doubt has been removed by the *adjudication* of invalidity, no subsequent act of copying can revive the invalid patent or entitle the patentee to relief from the judgment.

This was clearly recognized by the District Court, who said (petition, page 27):

> . . . imitation by the defendant, while it might in a doubtful case be some indication of the validity of a patent, certainly cannot be so interpreted when the patent has finally been held to lack patentable invention.

And as stated in the excerpt from the opinion of the Court of Appeals, quoted *supra*, page 2, the patented structure "was open to the defendant-appellee to copy if it saw fit." Hence, the Court of Appeals was clearly right in affirming the order of the District Court.

Conclusion

It is submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

Melvin R. Jenney
24 School Street
Boston 8, Massachusetts
Attorney for Respondent.

Richard R. Hildreth
Clarence S. Lyon
Of Counsel